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EXAMINER

CONTEE, J

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4

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
09/121,030

Applicant(s)
Alperovich et al.

Examiner
Joy K. Contee

Art Unit
2681



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 5, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection, discussed below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "partially" in claim 1 is a relative term which renders the claim indefinite. The term "partially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1,3-5, 8, 21 and 24 rejected under 35 U.S.C. 102(e) as being anticipated by Dahlin et al. ("Dahlin"), U.S. Patent No. 6,122,263.

Regarding claim 1, Dahlin discloses in a telecommunications system, a method for selectively forwarding incoming messages to a subscriber over a packet-switched network, said method comprising the steps of:

establishing, responsive at least [partially] to at least one input of said subscriber (i.e. using the man- machine input/output interface in the radio terminal), a call forwarding parameter (i.e., "receive buffer overflow message" or "instruction" or "code sequence") that indicates that messages of one or more predetermined information type parameters are to be forwarded over said packet-switched network (col. 5, lines 27-60);

receiving an incoming message for said subscriber, said incoming message for said subscriber having an information type parameter (i.e., "type of server or WWW server") associated therewith (col. 5, lines 62-67 to col. 1-4);

determining whether said information type server ("type of server") comports with said call forwarding parameter ("code sequence"); and if so, routing said incoming message, over said packet-switched network (col. 5, lines 62-67 to col. 6, lines 1-4).

Regarding claim 3, Dahlin discloses the method to claim 1, wherein said packet-switched network is the Internet (col. 3, lines 56-59).

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Regarding claim 4, Dahlin discloses the method according to claim 1, wherein said step of routing further comprises the step of routing said incoming message over said packet-switched network to an address destination on said packet-switched network (col. 5, lines 63-67 to col. 6, lines 1-4).

Regarding claim 5, Dahlin discloses the method according to claim 1, wherein said step of routing further comprises the step of routing said incoming message through said packet-switched network and then back to said telecommunications system (col. 5, lines 10-30).

Regarding claim 8, Dahlin discloses the method according to claim 1, wherein said incoming message includes a designated packet-switched network address destination (col. 5, lines 62-67 to col. 6, lines 1-4).

Regarding claim 21, Dahlin discloses a mobile terminal, associated with a subscriber, for selectively indicating the forwarding of an incoming message thereto over a packet-switched network said mobile terminal comprising:

input means for inputting, by said subscriber, a call forwarding activation request (i.e., control message), said call forwarding activation request stipulating that incoming messages of one or more predetermined information type parameters are to be forwarded [at least one of] over and through said packet-switched network (col. 4, lines 17-25 and col. 5, lines 27-59); and

transmission means for transmitting said call forwarding activation request, whereby said incoming message is forwarded for said subscriber, pursuant to said call forwarding activation request if an associated information type parameter of said incoming message corresponds to at

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least one of said one or more predetermined information type parameters, [at least one of] over and through said packet-switched network (col. 4, lines 17-25 and col. 5, lines 27-67 to col. 1-4)

Regarding claim 24, Dahlin discloses the mobile terminal according to claim 21, wherein said packet-switched network is the Internet and said call forwarding activation request comprises an Internet protocol address (col. 5, lines 62-67 to col. 6, lines 1-4).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2,22,23,25 and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlin et al. ("Dahlin"), U.S. Patent No. 6,122,263, in view of Hallenstal, U.S. Patent No. 6,125,126.

Regarding claim 2, which depends from 1, Dahlin discloses the limitations of claim 1. Dahlin does not explicitly disclose the method, wherein said step of establishing further comprises the steps:

transmitting, by said subscriber, a call forwarding activation request to a home location register; and storing, pursuant to said call forwarding activation request, said call forwarding parameter within said call forwarding parameter within said home location register.

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However, in a similar field of endeavor Hallenstal discloses the method, wherein said step of establishing further comprises the steps:

transmitting, by said subscriber, a call forwarding activation request to a home location register (col. 5, lines 50-58); and storing, pursuant to said call forwarding activation request, said call forwarding parameter within said home location register (col. 6, lines 24-40).

At the time of the invention it would have been obvious to one of ordinary skill in the art to have modified Dahlin to include in its mobile switching center (i.e., a home location register) a memory means for storing call forwarding parameters for the purpose of creating a user profile that can be changed and updated based on modified selective call forwarding parameters.

Regarding claim 22, which depends from 21, Dahlin discloses the mobile terminal according to claim 21. Dahlin does not explicitly disclose the method wherein said input means further comprises a key means for inputting said call forwarding activation request by pressing a single key.

However, Hallenstal suggests the method wherein said input means further comprises a key means for inputting said call forwarding activation request by pressing a single key (col. 2, lines 52-65 and col. 5, lines 50-67).

At the time of the invention it would have been obvious to one of ordinary skill in the art that a user would be able to send a control message which is programmed in the memory of the telephone, by the depression of a single key. Therefore the user would only have to depress a single button in order to activate call forwarding.

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Regarding claim 23, which depends from claim 21, Hallenstal discloses the mobile terminal according to claim 21. Dahlin does not explicitly disclose the method wherein said input means further comprises a menu means for inputting said call forwarding activation request.

However, in a similar field of endeavor, Hallenstal is evidence of the method wherein said input means further comprises a menu means for inputting said call forwarding activation request (col. 5, lines 32-49).

At the time of the invention it would have been obvious to one of ordinary skill in the art that Dahlin would have been modified to include a menu means for the subscriber when activating the call forwarding request for the purpose of giving the subscriber various options as is well known in the art.

Regarding claim 25, which depends from claim 24, Dahlin discloses the limitations of claim 24. Hallenstal suggests the mobile terminal, wherein said input means further comprises format checking means for checking whether a respective inputted protocol address is in a proper format (col. 5, lines 50-63).

At the time of the invention it would have been obvious to one of ordinary skill in the art that Dahlin would have been modified to include format checking means for the purpose of confirming a keypad code sequence in an effort to properly activate select call forwarding using the select call forwarding code.

Regarding claim 27, which depends from claim 21, Dahlin discloses the mobile terminal of claim 21. Hallenstal is evidence of the mobile terminal, further comprising Internet call

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forwarding indicator (i.e., voice prompt) means for providing an indication to a subscriber that Internet call forwarding is activated (col. 9, lines 1-19).

At the time of the invention it would have been obvious to one of ordinary skill in the art to have modified Dahlin to include an Internet call forwarding indicator means for providing an indication to a subscriber that Internet call forwarding is activated.

9. Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlin, in view of Pepe et al. ("Pepe"), U.S. Patent No. 5,742,905.

Regarding claim 6, which depends from claim 1, Dahlin discloses the limitations of claim 1. Dahlin does not explicitly disclose the method wherein said call forwarding parameter derived from said incoming message comprises an indication that said call forwarding is activated for data and fax information.

However, in the same field endeavor, Pepe is evidence of the method wherein said call forwarding parameter derived from said incoming message comprises an indication that said call forwarding is activated for data and fax information (col. 6, lines 34-67 and col. 7, lines 1-15).

At the time of the invention it would have been obvious to one of ordinary skill in the art that data and fax information would be included in the packet switched data sent and forwarding of the Internet or other packet switched network for the purpose communicating a large amount of text or other data via a mobile telephone or terminal.

10. Claim 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlin, in view of Tatchell et al., U.S. Patent No. 5,999,611.

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Regarding claim 7, Dahlin discloses the method according to claim 1. Dahlin does not explicitly disclose the method wherein said call forwarding parameter derived from said incoming message comprises an indication that said call forwarding is activated for incoming calls that incur toll messages.

However, in a similar field of endeavor Tatchell suggests the method wherein said call forwarding parameter derived from said incoming message comprises an indication that said call forwarding is activated for incoming calls that incur toll messages (col. 19, lines 25-38).

At the time of the invention it would have been obvious to one of ordinary skill in the art that Dahlin would be modified to include a forwarding parameter within the call forwarding activation request, which indicates whether or not the incoming call would incur toll charges.

Motivation for doing so, would have been for the purpose of selectively forwarding long distance calls via the Internet, in which they may not incur tolls.

11. Claims 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Hallenstal and Pepe, in view of Tatchell.

Regarding claim 16, the combination of Hallenstal and Pepe disclose the telecommunications system according to claim 10.

Tatchell further suggests the method wherein said call forwarding activation request includes a provision to forward via said packet-switched network incoming calls which incur toll charges (col. 19, lines 25-38).

At the time of the invention it would have been obvious to one of ordinary skill in the art that Hallenstal and Pepe, would be modified to include a forwarding parameter within the call

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forwarding activation request, which indicates whether or not the incoming call would incur toll charges.

Motivation for doing so, would have been for the purpose of selectively forwarding long distance calls via the internet, in which they may not incur tolls.

12. Claims 9-11, 15 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Hallenstal, in view of Pepe et al. ("Pepe"), U.S. Patent No. 5,742,905.

Regarding claim 9, Hallenstal discloses a telecommunications system for selectively forwarding an incoming message having an information type parameter for a subscriber over a packet-switched network, said system comprising:

a home location register, said home location register associated with said subscriber (col. 4, lines 41-53);

a home database (i.e., #27), said home database associated with said home location register (i.e., local exchange), said home database for storing therein a call forwarding profile (i.e., selective automatic call forwarding service record) containing therein at least one call forwarding parameter (i.e., trigger calling number) (col. 6, lines 25-27).

Hallenstal does not explicitly disclose at least one call forwarding parameter established by said subscriber to indicate that messages having one or more predetermined information type parameters are to be forwarded over said packet-switched network; and

routing means for routing said incoming message [at least one of] over and through said packet-switched network for said subscriber if said information type parameter corresponds to at least one of said one or more predetermined information type parameters.

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However, in a similar field of endeavor Pepe provides evidence of at least one call forwarding parameter (i.e., service related information for mapping services) established by said subscriber to indicate that messages having one or more predetermined information type parameters (i.e., specific profile for call associated services) are to be forwarded over said packet-switched network (col. 7, lines 4-15 and lines 49-59); and

routing means for routing said incoming message at least one of over and through said packet-switched network for said subscriber if said information type parameter (i.e, subscriber's profile) corresponds to at least one of said one or more predetermined information type parameters (i.e., specific medial delivery options) (col. 6, lines 34-65).

At the time of the invention it would have been obvious to one of ordinary skill in the art to have modified Hallenstal to include a call forwarding number (or address) so that a message maybe forwarded using a packet-switched network for economical (i.e., no long distance cost for communicating over the Internet) and technological (i.e., higher communication) advantages.

Regarding claim 10, which depends from 9, the combination of Hallenstal and Pepe disclose the telecommunications system according to claim 9. Pepe is further evidence of the system comprising:

a mobile terminal for transmitting by said subscriber a call forwarding activation request to said home location register, said call forwarding activation request updating said call forwarding profile of said subscriber within said home database (col. 6, lines 34-66 and col. 7, lines 49-59).

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At the time of the invention it would have been obvious to one of ordinary skill in the art to have modified Hallenstal to include a call forwarding number (or address) so that a message maybe forwarded using a packet-switched network for economical (i.e., no long distance cost for communicating over the Internet) and technological (i.e., higher communication) advantages.

Regarding claim 11, which depends from claim 10, Pepe discloses the system according to claim 10. Pepe is further evidence of the system, wherein said packet-switched network is the Internet (col. 7, lines 39-46).

At the time of the invention it would have been obvious to one of ordinary skill in the art to have modified Hallenstal call forwarding to a packet-switched network such as the Internet for the purpose of providing economical (i.e., no long distance cost for communicating over the Internet) and technological (i.e., higher communication) advantages.

Regarding claim 15, Farris discloses the telecommunications system according to claim 10.

Pepe also discloses the method wherein said call forwarding activation request includes a provision to forward via said packet-switched network incoming calls comprised of fax and data information (col. 6, lines 34-67 and col. 7, lines 1-15).

At the time of the invention it would have been obvious to one of ordinary skill in the art that data and fax information would be included in the packet switched data sent and forwarding of the Internet or other packet switched network for the purpose communicating a large amount of text or other data via a mobile telephone or terminal.

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Regarding claim 20, which depends from claim 9, Pepe discloses the limitations of claim 9. Pepe is further evidence of the telecommunications system, wherein said call forwarding activation request is transmitted to said home database via said packet-switched network (i.e. wireline email) (col. 7, lines 49-59).

At the time of the invention it would have been obvious to one of ordinary skill in the art to have modified Hallenstal to include means for the subscriber to communicate to a home location register (or local exchange) via a packet-switched network for the purpose of providing convenience (i.e., email) for the subscriber.

13. Claims 12-14 and 17-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Hallenstal and Pepe, in view of Dahlin.

Regarding claim 12, which depends from 10, Pepe discloses the limitations of claim 10. The combination of Hallenstal and Pepe do not explicitly disclose the system, wherein said call forwarding activation request includes an Internet protocol address destination.

Dahlin is evidence of the system, wherein said call forwarding activation request includes an Internet protocol address destination (col. 5, lines 62-67 to col. 6, lines 1-4).

At the time of the invention it would have been obvious to one of ordinary skill in the art for a user to input an Internet protocol address destination as part of the call forwarding request (i.e. forwarding number or address) for the purpose of supplying the home database or local exchange with the information needed to forward or route the call over the packet-switched network.

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Regarding claim 13, which depends on claim 12, Pepe discloses the telecommunications system according to claim 12. Pepe further discloses the system, wherein said Internet protocol address destination is associated with a terminal connected to said Internet (col. 5, lines 62-67 to col. 6, lines 1-4).

At the time of the invention it would have been obvious to one of ordinary skill in the art for a user to input an Internet protocol address destination (associated with a terminal) as part of the call forwarding request (i.e. forwarding number or address) for the purpose of supplying the home database or local exchange with information needed to forward or route the call over the packet-switched network and to provide "personal mobility".

Regarding claim 14, which depends on claim 12, Pepe discloses the telecommunications system according to claim 12. Pepe further discloses the telecommunications system, wherein said Internet protocol address destination is associated with said mobile terminal (col. 5, lines 62-67 to col. 6, lines 1-4).

At the time of the invention it would have been obvious to one of ordinary skill in the art for a user to input an Internet protocol address destination (associated with a mobile terminal) as part of the call forwarding request (i.e. forwarding number or address) for the purpose of supplying the home database or local exchange with information needed to forward or route the call over the packet-switched network and to provide "personal mobility".

Regarding claim 17, which depends on claim 10, Pepe discloses the telecommunications system according to claim 10. Pepe further discloses the system, wherein said subscriber inputs a

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designated Internet protocol address destination to said mobile terminal (col. 5, lines 62-67 to col. 6, lines 1-4).

At the time of the invention it would have been obvious to one of ordinary skill in the art for a user to input an Internet protocol address destination as part of the call forwarding request (i.e. forwarding number or address) for the purpose of supplying the home database or local exchange with information needed to forward or route the call over the packet-switched network.

Regarding claim 18, which depends on claim 17, Pepe discloses the telecommunications system according to claim 17. Pepe further discloses the system, wherein said mobile terminal checks said designated Internet protocol address destination (col. 5, lines 62-67 to col. 6, lines 1-4).

At the time of the invention it would have been obvious to one of ordinary skill in the art for a user to input an Internet protocol address destination as part of the call forwarding request (i.e. forwarding number or address) for the purpose of supplying the home database or local exchange with information needed to forward or route the call over the packet-switched network.

Regarding claim 19, which depends on claim 17, Pepe discloses the telecommunications system according to claim 17. Pepe further discloses the system, wherein said mobile terminal, in conjunction with a mobile switching center, verifies (inherently the switch and control section will check the address of the URL in order to route the call) the existence of said designated Internet protocol address destination (col. 5, lines 62-67 to col. 6, lines 1-4).

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At the time of the invention it would have been obvious to one of ordinary skill in the art for a user to input an Internet protocol address destination as part of the call forwarding request (i.e. forwarding number or address) for the purpose of supplying the home database or local exchange with information needed to forward or route the call over the packet-switched network.

14. Claim 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlin.

Regarding claim 26, which depends from claim 21, Dahlin discloses the limitations of claim 21.

Dahlin does not explicitly disclose the mobile terminal wherein said call forwarding activation request is selected from the group comprising of (I) fax and data only Internet call forwarding, (ii) long distance only Internet call forwarding, (iii) email Internet protocol address call forwarding, and (iv) combinations of (I), (ii) and/or (iii).

However, at the time of the invention it would have been obvious to one of ordinary skill in the art that a user would be able to select from predetermined groups which medium incoming calls are to be forwarded. Dahlin gives motivation for grouping call types based on capacity/speed, Internet address, cost of call (see Dahlin, col. 5, lines 27-67 to col. 6, lines 1-12).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Norris et al., U.S. Patent No. 5,805,587, discloses a call notification feature for a telephone line connected to the Internet.

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Holmes et al., U.S. Patent No. 6,178,331, discloses a system and process for allowing wireless messaging.

Perinpanathan et al., U.S. Patent No. 6,144,671, discloses a call redirection method in a packet based communications network.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K. Contee whose telephone number is (703) 308-0149.

The Examiner may be reached Monday through Friday from 6:00 a.m. to 2:30 p.m. If attempts to reach the Examiner prove unsuccessful, her supervisor, Dwayne Bost can be contacted on (703)305-4778.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6296, (for formal communications intended for entry)

Or:


(703) 305-6306, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington.

VA., Sixth Floor (Receptionist).


Joy K. Contee

May 4, 2001


TRACY LEGREE
PRIMARY EXAMINER